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35 U.S.C § 102(e) as being anticipated by McAllister *et al.* (U.S. Patent No. 6,442,242) or rejected under 35 U.S.C. § 103 as unpatentable over McAllister in view of Kahawara. As will be shown below, McAllister does not anticipate claims 31-41. Furthermore, the combination of McAllister and Kawahara cannot support a *prima facie* case of obviousness. Applicants respectfully traverse the rejection below and request reconsideration of claims 31-41.

Claim Rejections – 35 U.S.C. §102

- ✧ Claims 31-41 stand rejected under 35 U.S.C § 102(e) as being anticipated by McAllister *et al.* (U.S. Patent No. 6,442,242). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”¹ Because McAllister does not teach each and every element of claims 31-41, the rejection should be withdrawn and the claims should be allowed.

Independent claim 31 recites a “method for specifying telephone services for a particular caller, comprising: receiving, at an intermediary device, an *authenticated caller identity for a call request from an origin device*. . . .” McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber² by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call.³ McAllister also discloses receiving a spoken caller name and retrieving subscriber-specific information to initiate subscriber-specific processing.⁴ McAllister does not disclose “receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device,” “receiving a caller profile for said authenticated caller

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

² McAllister, column 1, line 7, column 2, lines 29-30.

³ McAllister, column 5, lines 32-67.

⁴ McAllister, column 7, lines 17-32.

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identity" or "specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile" as claimed in claims 31, 35, and 39. McAllister does not even address authenticated caller identities. As such, McAllister cannot anticipate claims 31, 35, and 39. Dependent claims 32-34 depend from claims 31 and include all of the limitations of independent claim 31. Because McAllister does not anticipate claim 31, McAllister also does not anticipate claims 32-34. As such, claims 31 and 32-34 should be allowed.

Independent claims 35 and 39 claim a system and computer program product that correspond to the method claim of claim 31. Independent claim 35 claims a "system for specifying telephone services for a particular caller, comprising . . . means for receiving, at said intermediary device, *an authenticated caller identity for a call request from an origin device . . .*" Independent claim 39 claims a "computer program product for specifying telephone services for a particular caller, comprising . . . means, recorded on said recording medium, for *receiving an authenticated caller identity for a call request from an origin device . . .*" As discussed above, McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber⁵ by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call.⁶ McAllister also discloses receiving a spoken caller name and retrieving subscriber-specific information to initiate subscriber-specific processing.⁷ McAllister does not disclose "receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device," "receiving a caller profile for said authenticated caller identity" or "specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile" as claimed in claims 35, and 39. As such, McAllister cannot anticipate claims 31, 35, and 39. Furthermore,

⁵ McAllister, column 1, line 7, column 2, lines 29-30.

⁶ McAllister, column 5, lines 32-67.

⁷ McAllister, column 7, lines 17-32.

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dependent claims 36-38, and 40-41 depend from claims 35, and 39 respectively and include all of the limitations of their independent claims. Because McAllister does not anticipate independent claims 35 and 39, McAllister also does not anticipate dependent claims 32-34, 36-38, and 40-41. The rejection should be withdrawn, and claims 31-41 should be allowed.

Claim Rejections – 35 U.S.C. § 103

Claims 34, 38, and 41 stand rejected under 35 U.S.C. § 103(a) as unpatentable over McAllister in view of Kawahara (U.S. Patent Application No., 2002/0184096). The proposed combination of McAllister and Kawahara cannot establish a prima facie case of obviousness. To establish a prima facie case of obviousness, three basic criteria must be met.⁸ First, the combination must teach or suggest all of Applicants' claim limitations.⁹ Second, there must be a suggestion or motivation to combine the references.¹⁰ Finally, there must be a reasonable expectation of success in the combination.¹¹

The combination of McAllister and Kawahara does not teach or suggest all of Applicants' claim limitations. Rejected claims 34, 38, and 41 depend from claims 31, 35, and 39 respectively and include the limitations "receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device," "receiving a caller profile for said authenticated caller identity" or "specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile." As discussed above, McAllister discloses receiving the spoken name of a called party, retrieving a telephone number for that called party and

⁸ Manual of Patent Examining Procedure §2142.

⁹ *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

¹⁰ *In re Vaack*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

¹¹ *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986).

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forwarding the telephone number of the called party to a PBX to complete the call.¹² McAllister also discloses receiving a spoken caller name and retrieving subscriber-specific information to initiate subscriber-specific processing.¹³ Kawahara is an unrelated disclosure of a portable terminal device aimed at immediately providing a consumer with advertising information about goods that the consumer finds on another person.¹⁴ Neither McAllister nor Kawahara discloses "receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device," "receiving a caller profile for said authenticated caller identity" or "specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile." As such, the combination of McAllister and Kawahara cannot support a prima facie case of obviousness.

There is no suggestion or motivation to combine McAllister and Kawahara. McAllister discloses a call processing apparatus supporting autodialing and auto attendant functions.¹⁵ Kawahara discloses a portable terminal device aimed at immediately providing a consumer with advertising information about goods that the consumer finds on another person.¹⁶ There is simply no teaching in either McAllister or Kawahara suggesting combining a call processing apparatus with an advertising terminal device. As such, the combination of McAllister and Kawahara cannot support a prima facie case of obviousness.

There is also no reasonable expectation of success in the proposed combination. The combination of the call processing apparatus of McAllister and the portable terminal device will not work to receive, "at an intermediary device, an authenticated caller

¹² McAllister, column 5, lines 32-67.

¹³ McAllister, column 7, lines 17-32.

¹⁴ Kawahara, paragraph 0002, paragraph 014.

¹⁵ McAllister, abstract.

¹⁶ Kawahara, paragraph 0002, paragraph 014.

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identity for a call request from an origin device," "receiving a caller profile for said authenticated caller identity" or "specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile." As such, the combination of McAllister and Kawahara cannot support a prima facie case of obviousness.

Conclusion

McAllister does not teach each and every element of claims 31-41 and the combination of McAlister and Kawahara cannot support a prima facie case of obviousness. As such, claims 31-41 should be allowed. Applicants respectfully request the allowance of claims 31-41.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

Date: 12.19.03

By: _____

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